

DOCKET NO.: LUTR-0241/03-055 P2
Application No.: 10/824,248
Office Action Dated: July 21, 2008
Advisory Action Dated: November 5, 2008

PATENT

REMARKS

In summary, claims 1-97 are pending. Claims 1-24, 26-36, and 38-69 were withdrawn in response to previous restriction requirements. Claims 76-82 are subject to restriction in the instant Office Action and have been withdrawn by the Examiner. Claims 93-97 are newly added. Claims 25, 70, 71, 83, 84, 85, and 88 are rejected under 35 U.S.C. § 102. Claims 25, 37, 86, 87, and 89-92 are rejected under 35 U.S.C. § 103. Claims 72-75 contain allowable subject matter. Applicants traverse all rejections. Claims 72, 74, 86, and 90 are amended to correct typographical errors. Claims 25 and 37 are amended to indicate that the electronic ballast is configured to send a command and a ballast configuration. No new matter is added. Support for claim amendments can be found throughout the instant application, such as, for example, paragraph 0047 of the as-filed application.

Newly Added Claims

Newly added claims 93-97 are dependent claims that further describe the ballast control signal. Support for claims 93-97 can be found throughout the instant application, such as, for example, paragraphs 0029, 0030, 0043, and 0048, of the as-filed application.

Restriction

Claims 70-92 were newly added in the previous Office Action Response dated February 28, 2008. Examiner has deemed that claims 76-82 thereof are directed to an invention distinct from the invention as originally claimed and that claims 70-75 and 83-92 thereof are directed to the subject matter of previously elected claims. Thus, Examiner has withdrawn claims 76-82 and examined claims 70-75 and 83-92. Applicants expressly reserve the right to pursue the subject matter of claims 76-82 in one or more divisional applications and/or to rejoin claims 76-82 pursuant to MPEP § 821.04.

Claim Rejections - 35 U.S.C. § 102

Claims 25, 70, 71, 83, 84, 85, and 88 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,040,661, issued to Bogdan (hereinafter referred to as "Bogdan").

Bogdan neither discloses nor suggests "a port in electrical communications with said microprocessor for sending a first message ... comprising at least one command and ... a second message ... comprising at least one ballast configuration" (emphasis added) as recited in amended independent claim 25. In contrast, Bogdan teaches a port (port 127 in Figure 7, reproduced herein) for receiving downloaded software, but nowhere teaches that the port is for sending messages.

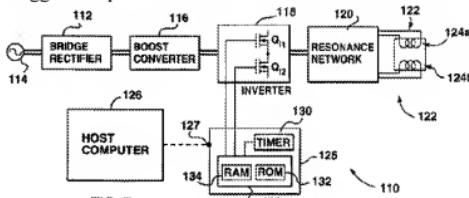


FIG. 7

Bogdan is directed to a programmable lighting system comprising a host computer that downloads routines to a microprocessor. (Abstract). The routines are downloaded via port 127, as shown in Figure 7 of Bogdan. Every description of the port 127 explains how the port is used to download information from the host computer to the microprocessor. Nowhere does Bogdan teach, or even contemplate, sending information from the microprocessor to the host computer. "Controller 125 is located within the casing of universal ballast 110 and is designed to receive information from an external host computer 126 through a ballast port 127." (Emphasis added) (Column 7, lines 53-56). "Once this program has been prepared, host computer 126 will download it through a conventional RS-232 interface to port 127 on ballast 110. Port 127 is coupled to microprocessor 128, such that the program can be delivered to and stored in RAM 134 where it will be ready for execution." (Emphasis added) (Column 8, lines 54-59). "Once this program has been prepared, host computer 126 will download it through port 127 to

microprocessor 128.” (Column 11, lines 23-25). Further, the information downloaded in Bogdan is a software routine, and does not even resemble a message comprising at least one of a command and a ballast configuration.

Because Bogdan neither discloses nor suggests “a port in electrical communications with said microprocessor for sending a first message … comprising at least one command and … a second message … comprising at least one ballast configuration,” it is requested that the rejection, under 35 U.S.C. § 102, of independent claim 25 and its dependent claims 70, 71, 83, 84, 85, and 88, be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 25, 37, 86, 87, and 89-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogdan in view of U.S. Patent No. 6,761,470, issued to Sid (hereinafter referred to as “Sid”).

A *prima facie* case of obviousness for rejecting claims 25, 37, 86, 87, and 89-92 has not been established because it has not been explained why one of skill in the art at the time of the claimed invention would have been motivated to combine Bogdan and Sid. And, it has not been explained how Bogdan and Sid would be combined/modified to arrive at the claimed subject matter.

As required by law in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Office must show, *inter alia*:

- (1) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (2) a reasonable expectation of success;
- (3) the basis for concluding that the claimed invention would have been obvious to do or obvious to try when there are only a finite number of identified, predictable solutions; and
- (4) the reference(s) teach(es) the claimed invention as a whole.

Further, the MPEP provides several guidelines for rejecting a claim under 35 U.S.C. 103(a).

Office personnel must explain why the differences(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. ... The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. (Emphasis added)
MPEP § 2141. III

Additionally, the Examiner should explain how to combine the references, per MPEP § 706.02(j).

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made**. (Emphasis added)

Moreover, when explaining how to modify a reference, “the proposed modification can not render the prior art unsatisfactory for its intended purpose” (MPEP § 2143.01.V), and “the proposed modification can not change the principle of operation of a reference.” (MPEP § 2143.01.VI).

In direct contradiction with the holding of *KSR*, Examiner's support for establishing obviousness consists of conclusory statements to desired results. See page 7 of the Office Action, which contains only the following conclusory statements to establish a *prima facie* case of obviousness. "It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize multiple ports connected to a microcontroller as taught by Sid lighting network into the Bogdan programmable lighting system in order to extend a controlling ability of a lighting system in a desire manner via user inputs/commands. Such implementation is considered as a routine skill in the art."

Examiner is reminded, per MPEP § 2143.01. IV, that "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. ... [R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Thus, the statement that it is considered "a routine skill in the art" is not sufficient to establish a *prima facie* case of obviousness.

Thus, Examiner has not provided, as required, an explanation of the motivation for combining the references and how to modify/combine the references. That is, no explanation is provided as to why one of ordinary skill in the art at the time of Applicants' invention would have sought out Bogdan and Sid, or how one of ordinary skill in the art at the time of Applicants' invention would have combined Bogdan and Sid, once found. For this reason alone (*i.e.*, a *prima facie* case of obviousness has not been established as required by law), it is requested that the rejection of claims 25, 37, 86, 87, and 89-92 under 35 U.S.C. § 103, be reconsidered and withdrawn.

Further, in contrast to MPEP § 2143.01.VI, attempting to combine Bogdan and Sid as suggested (“utilize multiple ports connected to a microcontroller as taught by Sid lighting network into the Bogdan programmable lighting system”), would change the principle of operation of the system taught in Bogdan. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01.VI).

One can not simply place multiple ports on the Bogdan system and expect it to work. The controller 125 of Bogdan is not designed to have multiple ports, and the microprocessor 128 is not programmed to handle information via additional ports. The controller 125 would have to be physically reconfigured to have multiple ports. And, the microprocessor 128 would have to be reprogrammed. Physically reconfiguring the controller and reprogramming the microprocessor requires more than a mere “routine skill in the art.”

Moreover, the principle of operation of the microprocessor 128 of Bogdan, is to interface with the inverter 118. The principle of operation does not include sending or receiving messages comprising a command and a ballast configuration. The microcontroller 200 of Sid does not interface with an inverter. Thus, one can not simply try to port the software from the microcontroller 200 of Sid to the microprocessor 128 of Bogdan. They are incompatible. In order to modify the microprocessor 128 of Bogdan to handle multiple ports, the principle of operation of the microprocessor 128 of Bogdan would have to be changed.

Because a *prima facie* case of obviousness has not been established as required by law, and because the proposed modification to the system of Bogdan would change the principle of operation of the system of Bogdan, it is requested that the rejection of claims 25, 37, 86, 87, and 89-92, under 35 U.S.C. § 103, be reconsidered and withdrawn.

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Allowable Subject Matter

Applicants note that claims 72-75 contain allowable subject matter.

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CONCLUSION

In view of the foregoing amendments, arguments, and remarks, it is submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

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